

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed January 25, 2006. Claims 1-22 were pending in the Application. In the Office Action, Claims 1-22 were rejected. Applicant adds new Claims 23-25. Thus, Claims 1-25 remain pending in the Application. Applicant respectfully requests reconsideration and favorable action in this case.

In the Office Action, the following actions were taken or matters were raised:

### **DRAWING OBJECTIONS**

In the Office action, the Examiner objected to the drawings and indicated that figure 1 of the drawings as originally filed should include the designation "Prior Art." Applicant has amended sheet 1 of the drawings to include the requested designation as indicated by the Examiner. A replacement sheet 1 of the drawings is attached hereto in Appendix A. Applicant respectfully submits that no new matter is added by replacement sheet 1. Applicant respectfully requests that the drawing objection be withdrawn.

### **SECTION 103 REJECTIONS**

Claims 1-3 and 5-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,760,722 issued to Hulikunta Raghunandan (hereinafter "*Raghunandan*") in view of the publication "ASPI for Win32" issued by Adaptec, Inc. (hereinafter "*Adaptec*"). Claims 4, 11-16 and 16-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Raghunandan* in view of *Adaptec* and further in view of U.S. Patent 6,065,096 issued to Brian A. Day et al. (hereinafter "*Day*"). Applicant respectfully traverses these rejections.

Of the rejected claims, Claims 1, 11 and 16 are independent. Applicant respectfully submits that each of independent Claims 1, 11 and 16 are patentable over the cited references. For example, in the Office Action, the Examiner asserts that *Raghunandan* purportedly teaches "receiving an input/output request formatted in accordance with an application programming interface," but that *Raghunandan* fails to teach "generating an input/output request formatted in

accordance with an adapter interface layer” as recited by Claim 1 (Office Action, page 3). The Examiner further states that *Adaptec* purportedly teaches formatting an input/output request in accordance with an adapter interface layer, and that it would have been obvious to combine the purported teachings of *Raghunandan* and *Adaptec* to “allow developers to write device drivers and applications which are independent of the specific host adapter platform” (Office Action, pages 3 and 4). Applicant respectfully disagrees.

Applicant respectfully reminds the Examiner that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *Id.* Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. For example, Applicant respectfully submits that there appears to be no motivation or suggestion for combining the cited references as suggested by the Examiner. The *Adaptec* reference is directed toward an interface, namely, the Advanced SCSI Programming Interface (ASPI), for enabling an application to interface to a SCSI peripheral (*Adaptec*, pages 1 and 2). However, the *Raghunandan* reference does not disclose or even

suggest the use of any SCSI peripheral device, nor has the Examiner explicitly identified any such disclosure in the *Raghunandan* that would prompt any proposed use of an ASPI therewith. Additionally, in the Office Action, the Examiner states that the *Adaptec* reference “allow[s] developers to write device drivers and applications which are independent of the specific host adapter platform” (Office Action, pages 3 and 4). However, the Examiner has not explicitly identified any disclosure in the *Raghunandan* reference that in any way indicates that any application of the *Raghunandan* reference requires the use of the ASPI or that any application of the *Raghunandan* reference is dependent on a specific host adapter platform. Accordingly, for at least these reasons, Applicant respectfully submits that independent Claim 1 is patentable over the cited references.

Further, even if there is considered to be a motivation or suggestion to combine the purported reference teachings as suggested by the Examiner, which motivation Applicant respectfully submits is lacking, neither the *Raghunandan* reference nor the *Adaptec* reference, alone or in combination, disclose, teach or suggest receiving an input/output request formatted in accordance with an application programming interface (API) and then generating an input/output request formatted in accordance with an adapter interface layer as recited by Claim 1. The *Adaptec* reference appears to be directed toward “the protocol between ASPI client applications and the ASPI Manager” (*Adaptec*, page 1) (emphasis added). Neither *Raghunandan* nor *Adaptec*, alone or in combination, disclose, teach or suggest receiving an input/output request formatted in accordance with an application programming interface (API) and then generating an input/output request formatted in accordance with an adapter interface layer as recited by Claim 1. To the contrary, the *Adaptec* reference appears to be limited to processing only requests from ASPI client applications. Therefore, for at least this reason also, Applicant respectfully submits that Claim 1 is patentable over the cited references.

Independent Claim 11 recites “receiving, by a translation layer . . . an input/output request formatted in accordance with an application programming interface,” “generating, by the translation layer, an input/output request in a format compatible with an adapter interface layer of

an operating system” and “submitting the generated input/output request to the adapter interface layer” (emphasis added), and independent Claim 16 recites “a local interface communicatively coupling [a] processing element and [a] host adapter, the processing element operable to . . . receive an input/output request formatted in accordance with an application programming interface and generate an input/output request formatted in accordance with an adapter interface layer of an operating system, the generated input/output request dependent upon the received input/output request, the processing element operable to submit the generated input/output request to the adapter interface layer” (emphasis added). At least for the reasons discussed above in connection with independent Claim 1, Applicant respectfully submits that independent Claims 11 and 16 are also patentable over the cited references.

Claims 2-10, 12-15 and 17-22 depend respectively from independent Claims 1, 11 and 16. As discussed above, independent Claims 1, 11 and 16 are patentable over the cited references. Therefore, Claims 2-10, 12-15 and 17-22 that depend respectively from independent Claims 1, 11 and 16 are also patentable. Moreover, *Day* does not appear to remedy, nor did the Examiner rely on *Day* to remedy, at least the deficiencies of the *Raghunandan* and *Adaptec* references discussed above. Therefore, Applicant respectfully requests that the rejection of Claims 1-22 be withdrawn.

### **NEW CLAIMS**

Applicant adds new Claims 23-25. New Claims 24 and 25 depend from new independent Claim 23. Applicant respectfully submits that new Claims 23-25 are patentable over the cited art of record. Therefore, Applicant respectfully requests allowance of new Claims 23-25.

**CONCLUSION**

Applicant has made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

With the presentation of new Claims 23-25, an excess claim fee of \$350.00 pursuant to 37 C.F.R. § 1.16 is believed due. The Commissioner is hereby authorized to charge \$350.00 to Deposit Account No. 08-2025 of Hewlett-Packard Company to cover the excess claim fees. If, however, Applicant has miscalculated the fee due with this Response, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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